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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,310	08/06/2003	Jack Richard Warner	5853-244	8146

7590 06/09/2005

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,310

Applicant(s)

WARNER ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 and 20-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/04, 6/04, 9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-32 are pending in this application.

Applicant's election with traverse of the invention of Group I, claims 1-7 and 14-19 is acknowledged. Applicant argues that the inventions of Groups I and II are interrelated such that there would not be undue burden in examining these two groups. Applicant fails to appreciate the searching challenges presented by applicant's inventions. Group I reads on foods. For Group I, the Examiner must search in the food arts for food or nutritional items that happen to contain the amino acids, sugar, and preservatives of the instant invention. Plainly, such a search is unrelated to killing insects, as required in Group II.

Applicant also argues that since Group I is directed to an insect bait, its search would include methods of using these baits, i.e. Groups III, IV and V. However, as discussed above, the search for Group I is not merely limited to insect baits. It is required in Group I to search for prior art foods or nutritional products that contain the claimed ingredients: amino acids, sugar and preservative¹. Given the ubiquitous commonality of such ingredients in foods, the search burden is already more than sufficient for Group I. To have to additionally search and examine distinct concepts embodied in Groups II, III, IV and/or V would raise the burden on the Examiner to a level that would be undue.

¹ See for example the cited reference below, Nakamura, published in the J. of Japanese Soc. of Nutrition and Food Science.

Therefore, for the reasons of record and rebuttal reasons set forth herein, the restriction requirement is still deemed to be proper and is thereby maintained.

Pursuant to the restriction requirement and applicant's election, claims 8-13 and 20-32 are withdrawn from further consideration as being directed to non-elected subject matter; and claims **1-7 and 14-19** will presently be examined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 7, 14, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al.

Nakamura et al. explicitly disclose an extract of ume that contains 0.6-1 wt% amino acids (asparagine being the major part), the sugars fructose, glucose and sucrose, and citric acid. See page 232, left column; Tables 4 and 6 on page 234.

Nakamura's composition therefore contains the same exact ingredients as the insect bait claimed by applicant in instant claims 1-2, 4-5, 7, 14, 16-17 and 19. While Nakamura does not explicitly disclose that his ume extract is an insect bait, such a property would necessarily be present in the extract since the same identical ingredients

are in the extract as in the claimed bait. The claims are thereby anticipated. MPEP 2112, 2112.01.

Claims 1, 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Soller et al. (US 6,223,465).

Soller et al. explicitly disclose a liquid insect bait, which contains 10-20% corn syrup, 5-15% sucrose (total of 15-35% corn syrup + sucrose), 1-10% protein, and 0.001-0.2% preservative (column 4, lines 3-14). Inclusion of amino acids is taught (column 4, lines 13-14).

In the absence of further claim requirements, it is the Examiner's interpretation that Soller's protein is within the scope of applicant's "plurality of amino acids" since proteins contain plurality of amino acids. The claimed 2-7 wt/v% is clearly met by Soller's 1-10% of protein². Further, Soller et al. explicitly disclose 35% corn syrup + sucrose, so the sugar concentration feature is met. The claims are thereby anticipated.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

² One of ordinary skill in the art would have readily recognized that Soller's percentages are weight/volume, just like applicant's, given the context of solid additives in water/fluids.

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soller et al. in view of Derwent abstract 1977-44395Y and The Merck Index.

Soller et al. disclose a liquid insect bait, which contains 10-20% corn syrup, 5-15% sucrose (total of 15-35% corn syrup + sucrose), 1-10% protein, and 0.001-0.2% preservative (column 4, lines 3-14). Inclusion of amino acids is taught (column 4, lines 13-14). Control of ants are taught (column 3, line 40).

Derwent abstract 1977-44395Y teaches that an amino acid mixture that includes asparagine is used in combination with sugars to attract ants.

The Merck Index discloses the well-known fact that sodium benzoate is a food preservative.

The difference between the claimed invention and Soller et al. is that Soller et al. do not explicitly disclose including asparagine in their insect bait. However, one having ordinary skill in the art would have been motivated to select asparagine as one of the desirable amino acids to include in Soller's bait (useful against ants), because asparagine has been taught to be useful in ant baits. As for sodium benzoate, its selection as the preservative in Soller's food-type bait against ants would have been obvious to the ordinary skilled artisan because (i) Soller et al. require the use of a preservative, and (ii) The Merck Index establishes the well-known food preservative use of sodium benzoate. With respect to the percentage of the amino acids and sugars,

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Soller's 35% corn syrup + sucrose clearly teaches the claimed sugar concentration; and as discussed above, which discussion is incorporated herein by reference, Soller's 1-10% protein discloses and fairly suggests plurality of amino acids at 2-7 w/v%.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly suggested by the teachings of the cited references.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machines is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner John Pak whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Mr. Gary Kunz, can be reached on **(571)272-0887**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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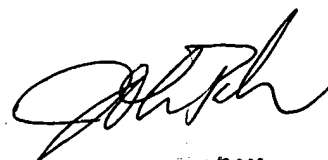
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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have a question on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'John Pak', is positioned above the printed name and title.

JOHN PAK
PRIMARY EXAMINER
GROUP 1600